

Appln. No. 10/706,425
Filing Date: November 12, 2003
Amendment filed May 16, 2008
Reply to Advisory Action mailed April 10, 2008

REMARKS

Claims 22-55 are pending in the Application, all were rejected in the final Office action mailed December 19, 2007, and the rejections were maintained in the Advisory Action mailed April 10, 2008. Claims 22, 37, and 49 are amended by this response. Claims 22, 37, and 49 are independent claims. Claims 23-36, 38-48, and 50-55 depend, respectively, from claims 22, 37, and 49. Applicants respectfully request reconsideration of pending claims 22-55, for at least the reasons set forth during prior prosecution, and for the reasons set forth below.

Claim Rejections

Claims 22-55 were rejected under 35 U.S.C. §103(a) as being unpatentable over Meyerson et al. (US 5,579,487, hereinafter "Meyerson") in view of Morris et al. (US 4,884,132, hereinafter "Morris"). Applicants respectfully traverse the rejection. Notwithstanding the above, Applicants have amended claims 22, 37, and 49 as set forth above solely to clarify the language of the claims.

Applicants respectfully submit that the Office action has failed to establish a *prima facie* case of obviousness, in accordance with M.P.E.P. §2142. According to M.P.E.P. §2142, "[t]he examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." M.P.E.P. §2142 further states that "[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious." As recognized in M.P.E.P. §2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007), 82 USPQ2d 1385, 1396 noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit." In addition, the Federal Circuit has made clear that "rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated

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reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 127 S. Ct. 1727 (2007), 82 USPQ2d at 1396.

Applicants respectfully submit that the Office action of December 19, 2007, and the Advisory Action mailed April 10, 2008 failed to establish a *prima facie* case of obviousness, in that the proposed combination of references fails to teach, suggest, or disclose, at least, “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited in amended claims 22, 37, and 49. Applicants respectfully submit that the Office failed to consider all of the features of Applicants’ claim 22, 37, and 49, choosing to ignore the significance of the term “selecting”. Applicants have amended claims 22, 37, and 49, solely to make this aspect of claims 22, 37, and 49 even more clear.

The Applicants appreciate recognition by the Office that Meyerson “...does not expressly disclose using the wireless communication interface for transmitting image; and a path used by the device to wirelessly communicate data is automatically selected based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data.” See Office action at page 3. The Office, however, then relies upon Morris to remedy this shortcoming of Meyerson, and states that Morris teaches “...an image being processed and transmitted over a cellular network (column 1, lines 35-39); and selecting a path automatically to be used by the device to wirelessly communicate data based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data (column 1, lines 35-68, processed image data and/or speech data are transmitted wirelessly).” See Office action at page 3. Applicants respectfully disagree with what Morris is alleged to teach.

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Applicants respectfully maintain that the proposed combination of references does not teach "...selecting a path automatically to be used by the device to wirelessly communicate data based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data...", as alleged by the Office, in that Morris discloses the availability and use of only one path. The word "select" may be defined as "...to choose (as by fitness or excellence) from a number or group: to pick out...." See Merriam-Webster's Collegiate Dictionary, Tenth Edition, Merriam-Webster Incorporated, 2002, page 1056. Therefore, Applicants respectfully submit that Morris does not perform a selection of a path, in that Morris discloses only one path, and merely uses the only path available. Morris states at column 1, lines 51-53 that "...a preferred personal security system has a portable unit having a cellular communication transmitter and a remote unit having a cellular communication receiver." Applicants respectfully submit that Morris fails to disclose that the "personal security system" has the ability to select from more than just the "cellular transmitter", or to have any other paths for transmitting image or audio information. Indeed, Morris certainly does not disclose that the "personal security system" functions such that "...a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited in amended claims 22, 37, and 49.

Applicants respectfully note that the Office cites Morris only at column 1, lines 35-68 in support of the contention that Morris remedies the admitted shortcomings of Meyerson. Applicants first address the alleged teachings of Morris at column 1, lines 21-43, which includes a portion of Morris cited by the Office (underlined), which states:

The personal security system transmits a picture of an object, such as a criminal suspect, and the identification of a portable transmitter, such as the social security number of the user, to a receiver at a remote location. Time of

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transmission is recorded. If a crime occurs, the time, picture of the suspect, and identification of the victim are obtained from a recorder at the receiver. A potential victim of a crime points his portable personal security unit at a criminal suspect and presses an activating switch. The unit senses available light on the object and provides a flash if required. At the same time focusing an aperture control is performed and an image of the object is admitted to an image recorder which is a focal plane sensor array. Image data from the focal plane sensor array is processed in an image data processor and the processed image data is fed to a cellular communication transmitter for transmitting to the remote receiving station. An audio pickup at the portable unit is connected to the receiver for transmitting voice communications over the transmitter. By pointing the device at a suspect and pressing a button, a person makes a permanent record of an image.

(underline added)

Applicants respectfully maintain that the portion of Morris shown above simply teaches that a “personal security unit” is used to capture and transmit an image of a suspected criminal, time information, and audio via a cellular communication transmitter to a remote receiving station. The cited portion of Morris does not however, teach or suggest, at least, “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited in amended claims 22, 37, and 49. Instead, Morris teaches that the image data, the time, and audio information are transmitted only via a cellular communication transmitter to a remote receiving station. Morris fails to teach anything with respect to any other paths, and certainly does not teach the availability of a number or group of paths from which to choose. There is no disclosure related to the selection of the path used in communicating the image data,

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the time, or the audio information. Therefore, Applicants respectfully submit that the portion of Morris shown above does not teach or suggest at least this aspect of Applicants' amended claims 22, 37, and 49.

Applicants next address the alleged teachings of Morris at column 1, lines 44-47, which states:

A preferred personal security system has a hand-held unit having a digital image sensor and transmitter for transmitting a digital image and digital information to a remote location.

Applicants respectfully submit that the portion of Morris shown above simply teaches that the "personal security unit" preferably is a handheld unit with a digital image sensor and a transmitter for transmitting a digital image to a remote location. Applicants respectfully submit, however, that the cited portion of Morris does not teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited in amended claims 22, 37, and 49. Again, the cited portion of Morris fails to say anything about the availability if a number or group of paths from which to choose, and therefore does not teach selection of a communication path, let alone path selection based upon a type of data being communicated, in accordance with Applicants' amended claims 22, 37, and 49. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least this aspect of Applicants' claims 22, 37, and 49.

The Applicants' now turn to the alleged teachings of Morris, at column 1, lines 48-50, which states:

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The preferred personal security system further has an aperture optically aligned with the sensor for permitting an image to pass through to the sensor.

While the portion of Morris shown above does state that the “personal security system” of Morris preferably has an aperture optically aligned so as to permit an image to pass to a sensor, this portion of Morris, also specifically identified by the Office, fails to teach or suggest, at least, “...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...”, as recited in amended claims 22, 37, and 49. The portion shown above, which was also specifically cited by the Office fails to say anything about selection of a communication path, or to even mention path selection based upon a type of data being communicated, in accordance with Applicants’ claims 22, 37, and 49. The cited portion of Morris does not teach of a number or group of communication paths from which to choose. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least this aspect of Applicants’ amended claims 22, 37, and 49.

Applicants now address the alleged teachings of Morris at column 1, lines 51-53, which states:

Preferably, the hand-held unit includes a cellular transmitter and the image sensor is a surface image to digital signal conversion chip.

Applicants respectfully submit that this portion of Morris clearly teaches that Morris has identified cellular communication as the preferred mode, and that the image sensor is preferably “a surface image to digital signal conversion chip.” The cited portion of Morris, specifically identified by the Office, does not, however, make any

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mention of any other communication paths other than cellular communication, nor does it teach choosing from a number or group of communication paths. Accordingly, it necessarily does not teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited in amended claims 22, 37, and 49. Again, the cited portion fails to say anything about selection of a communication path, or to discuss path selection based upon a type of data being communicated, in accordance with Applicants' amended claims 22, 37, and 49. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least this aspect of Applicants' amended claims 22, 37, and 49.

The Applicants' continue by reviewing the alleged teachings of Morris, at column 1, lines 54-64, which states:

The preferred hand-held unit comprises a start button, a master control function unit connected to the start button, and an electronic power source, an illumination unit, a light sensor unit, a projection lens control unit, an aperture control unit, an image recording unit having a focal plane sensor array, an image processing unit connected to the image recording unit and a cellular communication unit. All of the units are connected to the master control unit and connected to the image processing unit for broadcasting signals from the image processing unit to a distant cellular receiving station.

The portion of Morris shown above merely describes the various elements of the "personal security system" of Morris. Again, this passage from Morris identifies the use of cellular communication for the communication of image signals to a distant receiving

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station. This portion of Morris, specifically identified by the Office, does not, however, teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited in amended claims 22, 37, and 49. Once again, the cited portion fails to say anything about the availability of a number or group of communication paths or alternatives, about selection of a communication path from such a group, or to even mention path selection based upon a type of data being communicated, in accordance with Applicants' amended claims 22, 37, and 49. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least this aspect of Applicants' claims 22, 37, and 49.

Finally, Applicants address the alleged teachings of the portion of Morris at column 1, lines 65-68, which states:

The preferred personal security system further comprises an audio recording unit connected to the cellular communication unit for providing a digital audio signal to the cellular communication unit.

Applicants respectfully submit that the portion of Morris shown above teaches that the "personal security system" of Morris preferably has an audio recording unit connected to provide a digital audio signal to a cellular communication unit. As is clearly stated, Morris again identifies cellular communication for use in communicating information from the "personal security system" to a distant receiving station. This last portion of Morris, however, which was specifically identified by the Office, does not teach or suggest, at least, "...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths

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based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited in amended claims 22, 37, and 49. The cited portion of Morris fails to say anything about a number or group of communication path from which to choose, about selection of a communication path from such alternatives, or to even mention path selection based upon a type of data being communicated, in accordance with Applicants' amended claims 22, 37, and 49. Therefore, Applicants respectfully submit that the portion of Morris shown above also does not teach or suggest at least this aspect of Applicants' claims 22, 37, and 49.

Applicants respectfully submit, for at least the reasons set forth above, that Morris fails to teach or suggest, at least, Applicants' feature "...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited in amended claims 22, 37, and 49. The Office has admitted that Meyerson "...does not expressly disclose using the wireless communication interface for transmitting image; and a path used by the device to wirelessly communicate data is automatically selected based upon a type of data being communicated wherein the type of data is one or both of processed image data/or speech data." See Office action at page 3. Applicants respectfully submit that, in light of the admitted shortcoming of Meyerson, Meyerson necessarily fails to teach or suggest "...wherein a path used by the device to wirelessly communicate data is automatically selected from a plurality of communication paths based upon a type of data being communicated, and wherein the type of data is one or both of processed image data and/or speech data...", as recited by Applicants' amended claim 22, 37, and 49. Applicants respectfully submit that because neither Morris nor Meyerson teach or suggest at least this aspect of Applicants' invention, the combination of Meyerson and Morris cannot, by definition, teach or suggest at least this feature of Applicants' amended claims 22, 37, and 49.

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Based at least upon the above, Applicants respectfully submit that the proposed combination of Meyerson and Morris fails to teach or suggest all of the limitations of Applicants amended claims 22, 37, and 49, and therefore, their respective dependent claims, as required by M.P.E.P. §2142, and that a rejection of claims 22, 37, and 49 and their respective dependent claims under 35 U.S.C. §103(a), cannot be maintained.

Therefore, Applicants believe that amended claims 22, 37, and 49 are allowable, for at least the reasons set forth above. Applicants respectfully submit that claims 23-36, 38-48, and 50-55 depend, respectively, from allowable claims 22, 37, and 49. Because claims 23-36, 38-48, and 50-55 depend from claims 22, 37, and 49, Applicants respectfully submit that claims 23-36, 38-48, and 50-55 are also allowable, for at least the same reasons. Therefore, Applicants respectfully request that the rejection of claims 22-55 under 35 U.S.C. §103(a) be reconsidered and withdrawn.

Conclusion

In general, the Office Action makes various statements regarding the claims and the cited references that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim). An early Office Action on the merits and allowance of claims 22-55 is respectfully requested.

Applicants respectfully submit that the claims of the present application should be in condition for allowance for at least the reasons discussed above. Applicants respectfully request that the finality of the Office action be withdrawn, and that the outstanding rejections be reconsidered. If the Examiner has any questions or Applicants can be of any assistance, the Examiner is invited to contact the undersigned.

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The Commissioner is hereby authorized to charge the fee of \$460.00 for the Petition, and any other fees required by this submission, or to refund any overpayment to the Deposit Account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

Respectfully submitted,

Dated: May 16, 2008

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